

Remarks

Claims 1-41 are pending. Claims 1-41 are rejected.

Claims 2-16, 18-22, 24-36 and 38-41 are rejected under 35 U.S.C. 112, second paragraph. The claims have been amended to address this rejection.

Claims 1-20, 22-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pub. No. 2002/0095368 (Tran) in view of U.S. Pub. No. 2006/0010377 (Anecki).

Tran does not appear to be prior art. Tran states that

This application claims priority from Provisional Application No. 60/200,962, filed on May 1, 2000 and Application Ser. No. 09/792,828 filed on Feb. 24, 2001, which claims priority from Provisional Application No. 60/185,644 filed on Feb. 29, 2000, the contents of which are incorporated by reference.

Tran, [0001], (emphasis added).

The phrase “claims priority from . . . Application Ser. No. 09/792,828 on Feb. 24 2001” does not appear to be a proper claim of priority. Tran does not state whether the application is a “continuation, divisional or continuation-in-part” of Application Ser. No. 09/792,828. See, Section 3: Benefit Claims To Prior Applications under 35 U.S.C. §§ 119(e), 120, 121, and 365(c) prepared by the Office of Patent Legal Administration (OPLA), (“**Benefit Claims To Prior Applications under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)** [m]ust include a specific reference to the prior-filed nonprovisional application . . . [s]pecific reference to a nonprovisional application requires the following: . . . 2. Indication of the **specific relationship** (i.e., continuation , divisional, or continuation-in-part) of the applications”) (emphasis in original). As such, the earliest effective filing date of Tran appears to be May 1, 2000, after the filing date of the instant application.

To the extent that Tran is prior art, with regard to claim 1, Tran does not appear to disclose forming an invention disclosure online by entering a plurality of selected information portions into a web-based system. The Examiner relies on passages in paragraphs [0014], [0016]-[0017] and [0020]-[0023] of Tran to find the above limitation. These passages, however, discuss processes associated with selling or trading IP assets. As an example, paragraph [0016] states that

The server 100 supports an intellectual property portal that provides a single point of integration, access, and navigation through the multiple enterprise systems and information sources facing knowledge workers operating the client workstations 104-106. In an exemplary user interface to support IP asset trading, the user interface is a web-based user interface. The user interface allows a user to sign-on or sign-off the system. The user interface also provides the user with a plurality of operating options accessible through clickable buttons, including "Buy IP Asset"; "Sell IP Asset"; "Register IP Asset"; "Appraise IP Asset"; "IP Escrow Service"; "Refer a Buyer"; and "IP Chat" buttons. Additionally, the user can access his or her specific interest by accessing a "Your Account" button, a "Your Listings" button, and a "Your Offers" button. Other buttons allow the user to utilize ancillary services such as "Trademark Search" button and "IP Monitoring" buttons.

Tran, [0016].

The selling or trading of IP assets has nothing to do with forming an invention disclosure online.

With regard to claim 1, Anecki does not appear to disclose allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information. The Examiner relies on the following passages of Anecki to find the above limitation:

Individuals responsible for the generation, approval, and tracking of legal documents, such as the administrator, directors, and legal counsel, use the extended services of the legal

document server to control the legal document creation and approval process. For example, directors establish the business rules by which and for whom a legal document can be produced; the directors also review the legal document request for technical accuracy and actual availability for each subject matter product in their domain; and the legal counsel approves the legal content of the legal document. The legal document server also provides services to track legal documents once the legal documents are issued to the customer.

The legal document server provides services to customers and marketing representatives to track the approval status of a legal document awaiting approval from directors. Customers use the previously described Recipient client to access the legal document server to determine the approval status of a legal document.

Anecki, [0046]-[0047].

In one embodiment of the present invention, the legal document is retained in the legal document database for status reporting and possible amendment. For example, a customer reviewing a computer chip and its specifications under a NDA may desire to obtain other computer chips. In this case, a new NDA is not generated. An amendment to the original NDA is generated and sent the customer for execution. The need for an amendment is detected when there is a change in status 1180 of the legal document. In which case, an amendment is generated 1190, the legal document database is updated, and the requestor is notified by a confirmation 1192 of the availability of the amendment.

In one embodiment of the present invention, the status of a legal document awaiting approval may be checked by the requester through the services of the legal document server. An address identifying the location of an approval status document is sent to the requester in an initial confirmation message 1120. The requestor uses the address of the approval status document to retrieve a approval status document that is updated by the legal document server as the legal document moves through the approval process.

Anecki, [0052]-[0053].

The above passages, however, simply do not discuss invention disclosures or inventors.

With regard to claim 1, Anecki does not appear to disclose allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation.

With regard to claim 17, Tran does not appear to disclose said server providing user screens to said at least one user computer to prompt said inventors to provide a plurality of disclosure information to said server, receiving the plurality of disclosure information from said users, and storing information in said database after each of the plurality of disclosure information is entered. The Examiner relies on passages in paragraphs [0014] and [0016]-[0018] of Tran to find the above limitations. As explained above, however, paragraphs [0014] and [0016]-[0017] discuss processes associated with selling or trading IP assets. Paragraph [0018] discusses generating trademark applications:

For trademark applications, another embodiment can walk the user through whether he or she wishes to generate use-based applications or intent-to-use (ITU) applications, which are available if one has not yet used the mark on goods. The system prompts the user to list all the goods with which the mark will be used, or has been used. This should be carefully worded to ensure that the registration is not unduly narrowed. The system then requests a description of how the mark is used. A trademark must be used on (or in connection with) the actual goods--advertising is not sufficient use. The system can ask if the mark is a composite mark (such as a logo plus words), then the system presents the user with a choice of registering the word mark alone, the word/logo combination, or the logo alone. The system also guides the user with the selection of specimens with a use application. These are actual labels, tags, or packaging. The system can then suggest alternatives such as photographs that can be sent instead of specimens when the specimen is not fiat, or when it is too large.

Tran, [0018].

Trademark applications and selling or trading IP assets has nothing to do with prompting inventors to provide a plurality of invention disclosure information and receiving and storing the invention disclosure information.

With regard to claim 17, Anecki does not appear to disclose allowing access to said disclosure after storing the plurality of disclosure information within said database and prompting said plurality of inventors for invention disclosure approval. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitation.

With regard to claim 23, Tran does not appear to disclose forming an invention disclosure online by entering a plurality of selected information into a web-based system. The Examiner relies on passages in paragraphs [0014], [0016]-[0017] and [0020]-[0023] of Tran to find the above limitation. As explained above, however, these passages discuss processes associated with selling or trading IP assets. The selling or trading of IP assets has nothing to do with forming an invention disclosure online.

With regard to claim 23, Tran does not appear to disclose prompting the user for classification information, which refers to a technology area. The Examiner relies on passages in paragraphs [0019] and [0043] of Tran to find the above limitation. These passages, however, discuss estimating the value of IP assets. As an example, paragraph [0019] states that

The Appraise button provides an electronic valuation module to estimate the value of the IP assets. Factors evaluated include term of duration of rights; status of applications made in foreign countries and fights approved there; litigation with third parties; licensing status; technical nature of invention (three categories: basic technology, vastly improved technology and marginally improved technology); related patents; technical dominance of the IP asset, as judged by degree to which invention has been developed into a superior concept, extent and clarity of specification; clarity of range of technology if there is something

unclear in the range of technology for which fights have been formed or there is concern over the occurrence of infringement-related disputes; relationship to use of IP rights possessed by third party; technical superiority to substitute technology; extent to which invention has been proven in real use; necessity of additional development for commercialization; markets for commercialization; transfer and distribution potential; inventors (or right-holders)'s intent to engage in continual research and development and the possibility of applying the results; potential restrictions on the places that it can be licensed to (such as limits on the term and region of implementation); the right-holder's ability to exercise its rights against infringing parties; the possibility that rights will be invalidated, canceled, or limited; the business potential of the invention; the possibility that substitute technology for the invention will be developed; the potential for competing or substitute products will appear; the ease that imitation products be easily manufactured; the ease of detecting infringing products; the size of the market, the market scale, the market share that is acquirable and the time frame for acquiring the targeted market share; the life span for the product's market; the price that a customer is willing to pay for the value generated by the relevant patent right; and the sustainability of the profit.

Tran, [0019].

Estimating the value of IP assets has nothing to do with prompting the user for classification information, which refers to a technology area.

With regard to claim 23, Anecki does not appear to disclose allowing access to various users to access the information, notifying an evaluator in response to the classification information and prompting an evaluation from the evaluator. As explained above, Anecki does not discuss invention disclosures or inventors. As such, Anecki cannot disclose the above limitations.

With regard to claim 37, Tran does not appear to disclose entering disclosure information to create an invention disclosure. The Examiner relies on passages in paragraph

[0034] to find this limitation. These passages, however, discuss the login procedure for a party interested in buying, selling or trading IP:

A party that is interested in buying, selling, or trading IP can log onto the system of FIG. 1 over a network. The network could be a local area network, wide area network, or global network such as the Internet. When a user wishes to access the system, he logs on using the selected user identification and a password. If the user identification and password are entered correctly, the system validates them and the user can proceed. If an incorrect password or user identification is entered, a message appears and the operator is prompted to re-enter the incorrect term. After a number of unsuccessful attempts, an error message is displayed and the operator is locked out of the system. If the password entered has expired due to the passage of a predetermined number of days, a password expiration screen can be displayed. This screen permits the user to select a new password and then access the system. It is not necessary to wait until a password expires. Rather, passwords can be changed at any time.

Tran, [0034].

A login procedure for a party interested in buying, selling or trading IP has nothing to do with entering disclosure information to create an invention disclosure.

With regard to claim 37, Tran does not appear to disclose coupling said user information with said invention disclosure. As explained above, Tran does not disclose entering disclosure information to create an invention disclosure. As such, Tran cannot disclose the above limitation.

With regard to claim 37, Anecki does not appear to disclose performing a search to determine the state of the art associated with said invention disclosure wherein said search is at least partially directed by at least one inventor of said invention disclosure. The Examiner relies on Figure 1 and passages in paragraph [0041] of Anecki to find the above limitation. These passages, however, discuss an email server:

The services of the legal document server are further extended by an email server 1080. The email server provides services to send email messages by the legal document server to the customer, marketing representatives, directors, administrators, and legal counsel. A single email server is shown for clarity and the use of a single email server is not intended as a limitation of the invention.

Anecki, [0041].

An email server has nothing to do with performing a search to determine the state of the art associate with said invention disclosure. Moreover, as explained above, Anecki does not discuss invention disclosures or inventors.

Assuming, *arguendo*, Tran and Anecki disclose each and every element of claims 1, 17, 23 and 37, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner asserts that it would have been obvious to combine Tran and Anecki “for the purpose of tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation using computerized processing” Tran, however, is directed to systems and methods for trading intellectual property. Tran, Abstract. Tran states that

Systems and methods cost-effectively are disclosed to facilitate and enhance the licensing and trading of IP assets. The system supports purchasing or selling of intellectual property related products and services with a computerized bid, auction and sale system over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP. The techniques support a service-based auction network of branded, online auctions to individuals, businesses, or business units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology.

Tran, [0006].

The apparent “open market for trading IP” provided by Tran has nothing to do with the “tracking of legal documents, reviewing information and tracking the status of legal documents, thereby, increasing the efficiency of document preparation.” Tran is directed to systems and methods to “facilitate and enhance the licensing and trading of IP assets.” Tran, [0016]. The licensing and trading of IP assets has nothing to do with “document preparation.” One of ordinary skill, therefore, would not have had reason to combine Anecki with Tran.

Claims 2-16, 18-22, 24-36 and 38-41 are patentable because they depend from one of the independent claims.

Applicants’ Attorney submits that the claims are in a condition for allowance. Applicants’ Attorney respectfully requests a notice to that effect. Applicants’ Attorney also invites a telephone conference if the Examiner believes that it will advance the prosecution of this application.

Please charge any additional fees or credit any overpayments as a result of the filing of this paper to Deposit Account No. 06-1510.

Respectfully submitted,

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